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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

101160-00026

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Signature _____

Typed or printed name _____

Application Number

10/774,472

Filed

February 10, 2004

First Named Inventor

Yoshiaki TATSUMI et al.

Art Unit

1711

Examiner

TRAN, Thao T.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)☒

attorney or agent of record.

Registration number 44,275

☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

Murat Ozgu
Typed or printed name

Signature

Typed or printed name

202-857-6000

Telephone number

May 22, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.

☒

Total of 1 forms are submitted.

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THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Confirmation No.: 9149

Yoshiaki TATSUMI et al.

Art Unit: 1711

Application No.: 10/774,472

Examiner: Thao T. TRAN

Filed: February 10, 2004

Attorney Dkt. No.: 101160-00026

For: ELECTROSTATIC CHUCKING DEVICE AND MANUFACTURING METHOD
THEREOF

PRE-APPEAL BRIEF REQUEST FOR REVIEW

MAIL STOP AF

Commissioner for Patents

P.O. Box 1450

Alexandria, Virginia 22313-1450

Date: **MAY 22, 2006**

Sir:

The Applicants respectfully request the Response dated April 20, 2006, which was filed in reply to the outstanding Office Action dated January 10, 2006, be considered and entered into the record so that prosecution of the subject application may continue because the April 20 Response does not introduce new matter for the reasons provided herein. No amendments are being filed with this request. This request is being filed with a Notice of Appeal.

REMARKS

Claims 1-2 and 5-19 are pending in the subject application, wherein Claims 7-9 and 12-17 have been withdrawn from consideration by the Examiner for being directed to non-elected subject matter. The outstanding Office Action is the second Office Action in this application. Therefore, the application qualifies for Appeal.

In the outstanding Office Action, Claims 1-2, 5-6, and 18-19 are rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent Number 5,691,876 to Chen et al. (Chen) and Claims 10-11 are rejected under 35 U.S.C. §103(a) as being unpatentable over Chen. In a Response filed April 20, 2006, Applicants proposed amending Claim 1 as follows:

... an adhesion between the aluminum alloy metal substrate and the first insulation layer is performed by using a thermoplastic polyimide-based adhesive film having a film thickness of 5 to 50 μm and ~~by subjecting the thermoplastic polyimide-based adhesive film to a~~ capable of withstanding low-temperature compression bonding ~~processing under pressure at a~~ temperature of 100 to 250°C.

An Advisory Action dated May 2, 2006 indicated the April 20 Response was considered but deemed not to place the application in condition for allowance. The reason stated by the Examiner for the April 20 Response not placing the application in condition for allowance is that the proposed amendments to Claim 1 in the April 20 Response are alleged to introduce new matter.

Specifically, the Examiner asserts the feature "capable of withstanding" that was added by amendment in the April 20 Response is considered new matter because there is no adequate support for the feature anywhere in the originally filed specification. The Examiner notes the specification provides support for the step of low-temperature

compression bonding processing being performed at a temperature of 100°C to 250°C under pressure to form a laminate structure. However, the Examiner asserts the specification fails to provide support for the adhesive film *specifically* being “capable of withstanding” low-temperature compression bonding.

The Applicants respectfully submit the Examiner’s assertion that the proposed amendments to Claim 1 introduce new matter is factually erroneous for at least the reason(s) set forth below.

Applicants are unaware of any statute, rule or procedure under U.S. Patent law and/or the M.P.E.P. which requires that patent applicants are required to use only those terms *specifically* disclosed in the specification in the claims of a patent application.

Moreover, as stated above, the Examiner takes the position that the proposed amendments to Claim 1, wherein the claim was amended to recite the adhesive film is “capable of withstanding” low-temperature compression bonding, lacks support in the originally filed application, apparently because the words “capable of withstanding” are not *specifically* contained in the specification as originally filed.

While Applicants concede the phrase “capable of withstanding” does not specifically appear in the specification as originally filed, Applicants respectfully disagree with the Examiner’s position that amending Claim 1 to recite such a phrase constitutes introduction of new matter for the following reason(s).

Claim 1 previously recited that adhesion between the aluminum alloy metal substrate and the first insulation layer was performed by using an adhesive film having a thickness of 5 to 50 μm and by subjecting the adhesive film to a low-temperature compression bonding process under a temperature of 100 to 250°C. The April 20

Response amended Claim 1 for clarification purposes to recite that adhesion between the aluminum alloy metal substrate and the first insulation layer was performed by using an adhesive film having a thickness of 5 to 50 μm and that is capable of withstanding a low-temperature compression bonding process under a temperature of 100 to 250°C. The April 20 Response reproduced the entire paragraph, i.e., paragraph [0022], from the originally filed application, which the Applicants submit provides support for the amendments to Claim 1. See page 9 of the April 20 Response.

From a linguistic standpoint, Applicants respectfully submit that an adhesive film which “can be subjected to” low temperature compression bonding, as is stated in originally filed paragraph [0022] of the application, is synonymous with an adhesive film “which is capable of withstanding” low temperature compression bonding, as is recited in the amendment to Claim 1 of the April 20 Response.

From a technical standpoint, Applicants respectfully submit that a reasonable person of ordinary skill in the art to which the claimed invention pertains would readily understand that an adhesive film that is “subjected to a low-temperature compression bonding process” would inherently be “capable of withstanding” the same low-temperature compression bonding process.

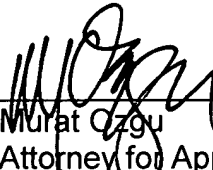
In view of the above, Applicants respectfully request the Examiner’s position be reconsidered as Applicants submit the Examiner’s assertion that the amendments to Claim 1 in the April 20 Response introduces new matter is factually incorrect since support for the language of the amendment is provided in paragraph [0022] of the originally filed application, which Applicants pointed out in the April 20 Response (see page 9).

II. Conclusion

For all of the above reasons, entry of the Response filed April 20, 2006 into the record so that prosecution of the subject application may continue is respectfully requested; a favorable decision; and allowance of all pending claims, are earnestly solicited.

In the event this paper is not considered to be timely filed, the Applicants respectfully petition for an appropriate extension of time. Any fees for such an extension, together with any additional fees that may be due with respect to this paper, may be charged to counsel's Deposit Account No. 01-2300, **referencing Attorney Dkt. No. 101160-00026.**

Respectfully submitted,



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Enclosures: Notice of Appeal to the BPAI and Petition
For Extension of Time
Pre-Appeal Brief Request for Review (Form PTO/SB/33)